

TTAB


Application Serial No. 76/ 506,584
Request for Remand

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TRADEMARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Wella Aktiengesellschaft

Serial No.: 76/ 506,584

Filed: April 16, 2003

For: COLOR COMPLETE

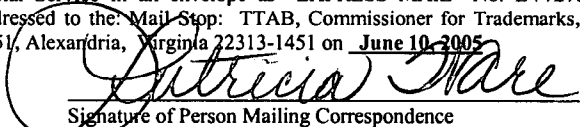
Examiner: Amos T. Matthews

Law Office: 108

REQUEST FOR REMAND

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Wella Aktiengesellschaft) Examiner: Amos T. Matthews
Serial No.: 76/ 506,584) Law Office: 108
Filed: April 16, 2003)
For: COLOR COMPLETE)
Docket No.: 7130-126XX/10303992)
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

REQUEST FOR REMAND

Applicant is requesting that its application be remanded to the Examining Attorney for consideration of the following Amendment to the description of goods. The Amendment deletes hair coloring products from the goods in Applicant's trademark application. Applicant submits that the Amendment addresses the Examining Attorney's concerns regarding descriptiveness and therefore overcomes the refusal to register under Section 2(e).

AMENDMENT

Please amend the description of goods to read as follows:

“Hair care preparations, namely, shampoos and hair conditioners; hair styling and finishing products, namely, hair sprays, spray gels, gels, mousses, creams, lotions, pomades and waxes; and hair and scalp treatments, namely, restructurizers and scalp conditioners, in Class 003.”

REMARKS

The Examining Attorney has refused registration of Applicant’s mark COLOR COMPLETE on the basis of descriptiveness. An excerpt from Applicant’s web site is pointed to as evidence that Applicant’s mark COLOR COMPLETE is descriptive. Office Action dated August 25, 2004 at page 2, lines 3 – 19, and Exhibits. The excerpt concerns a hair care product called a “sealer” that can be used in connection with a hair coloring product.

Although Applicant submits that its mark is not descriptive, Applicant has amended the description of goods by deleting hair colors and dyes, color removal and lightening preparations, and hair bleaches from the description of goods. Because all hair coloring products have been deleted, Applicant contends that COLOR COMPLETE is not descriptive of the hair care products remaining in the present application. At most, when used on shampoos and the other amended goods, COLOR COMPLETE can be understood as referring to a consumer’s hair, conveying the idea that the hair needs nothing more. By suggesting hair, Applicant’s mark does not describe the amended goods. Therefore, Applicant’s mark is entitled to registration on the Principal Register.

Moreover, Applicant submits that even if COLOR COMPLETE can be considered as referring to the amended goods, Applicant's mark is still not descriptive. A descriptive mark must immediately describe a feature or characteristic of the goods. *In re Abcor Development Corp.*, 588 F. 2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978). Therefore, a mark is not descriptive if it requires thought or imagination to convey an idea about the goods. *Id.*

In the present case, Applicant's mark does not immediately convey a feature or characteristic of the amended goods. Because the term "color complete" can suggest the hair, a consumer seeing COLOR COMPLETE on the amended goods would pause to consider whether the mark was a reference to hair or to the goods. Thus, to convey any idea about the goods themselves, thought and imagination would be required to distinguish the goods from the consumer's hair. Because COLOR COMPLETE does not immediately convey an idea of the amended goods, Applicant's mark is not descriptive.

Furthermore, by referring to a consumer's hair, COLOR COMPLETE suggests something other than the amended goods. A mark that has more than one meaning when applied to the goods is considered a "double entendre". Such a mark is entitled to registration as long as one of its meanings is not merely descriptive of the goods. T.M.E.P. 1213.05(c). Because COLOR COMPLETE suggests a consumer's hair when applied to shampoos and the other hair care products that remain in the present application, Applicant's mark has at least one meaning that is not merely descriptive of the amended goods. Accordingly, Applicant's mark is not descriptive.

In sum, Applicant's mark is not descriptive of the shampoos and other hair care products that remain in the present application following the deletion of hair coloring products. At most,

when used on the amended goods, Applicant's mark COLOR COMPLETE suggests a consumer's hair. Thus, Applicant's mark suggests something other than the goods and can be understood in more than one way when applied to the goods. All of this indicates that Applicant's mark is not descriptive and is therefore entitled to registration on the Principal Register.

In view of the foregoing amendment and remarks, Applicant submits that the present application is in condition for allowance. Applicant therefore respectfully requests that its application for COLOR COMPLETE be remanded to the Examining Attorney for consideration of the amendment.

No fees are believed due in connection with this request. However, if it is determined that a fee is required, the Commissioner is hereby authorized to charge and/or credit any such fees to our Deposit Account and reference our docket 7130-126XX/10303992. A duplicate copy of this paper is enclosed.

Respectfully submitted,



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